

Response Under 37 CFR 1.116  
Expedited Procedure  
Examining Group 2674

### Remarks

#### Claim Rejection - 35 USC 102(e)

Claims 1-11, 14 and 16-25 stand rejected as being unpatentable over US 6,130,666 to Persidsky.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Persidsky does not show each feature of the rejected claims.

Applicant reiterates the arguments presented previously, and further notes that Persidsky does not include a position determination device that absolutely determines the position of the writing instrument on the writing pad. Amended claim 1 emphasizes this distinction between Persidsky and the present invention by now including this feature, which recites two important and distinct features: the position determination device and the writing pad. Persidsky recites neither the position determination device, nor a writing pad as disclosed in the present invention. There is a strong distinction between Persidsky's accelerometer and the position determining device that absolutely determines the position of the writing instrument on the writing pad, as in the present invention.

In the present invention, the position of the writing instrument is measured directly and thus very exactly by the position determining device that absolutely determines the position of the writing instrument on the writing pad.

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The present Office Action argues that the above arguments are not persuasive.

We respectfully request that the Examiner review these arguments in relation to amended claim 1. We believe that, in consideration of amended claim 1, amended claim 1 is patentable over Persidsky.

Persidsky does not show the recording of an absolute position of the pen in relation to the writing pad. Especially in column 5, line 51 to 54 Persidsky offers no hint concerning a certain position relative to the writing pad. Instead, Persidsky describes a pen with an accelerometer used as a movement sensor.

It may be possible to determine a relative position of the pen from the measured data, for example to detect a blank space, although it can not be detected by the roller ball according to Persidsky. Maybe it is also possible to display a relative position of the pen on the monitor. But, Persidsky does not show measuring the position of the pen relative to the writing pad. According to Persidsky the position of the pen must be evaluated from data, e.g. time and acceleration, which is inexact. It is costly to add a means for calculating the position to Persidsky's invention. The present invention includes this costly feature in claim 1's position determination device.

Claim Rejection 35 USC 103(a)

Claims 12, 13 and 15 continue to stand rejected as being unpatentable over Persidsky in view of US 5,294,792 (Lewis et al (Lewis)).

Given the above arguments, not only is the present invention patentable over Persidsky, it is patentable over Persidsky in view of Lewis.

Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the

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claimed invention. US Court of Appeals for the Federal Circuit (*Ecolochem inc. v*

*Southern California Edison Co., Fed. Cir., No. 99/1043, 9/7/00).*

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.

Persidsky and Lewis do not motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

Court of Appeals for the Federal Circuit confirmed the above principles in *In Re Sang-Su Lee* (00-1158). The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

"Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.

"The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decision making." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

"As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or

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suggestion to select and combine the references relied on as evidence of obviousness.

(Emphasis added)

“The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so.”

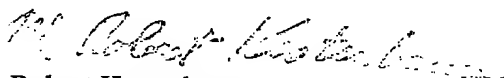
As stated above, Persidsky and Lewis do not motivate or suggest to a person skilled in the art to combine these references to duplicate the claims of the present invention.

Wherefore, further consideration and allowance of the claims is respectfully requested.

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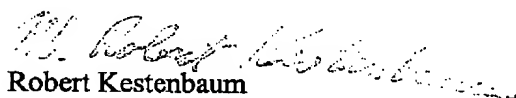
A Request for Continued Examination, together with a request for a three-month extension of time in which to respond to the outstanding Office Action is submitted herewith, in the form of the "Request for RCE Transmittal" and "Petition for Extension of Time Under 37 CFR 1.136(a) for Small Entity". Credit Card Payment Form PTO-2038 is enclosed to cover the prescribed Small Entity three-month extension fee of \$490, as well as the \$395 small entity RCE fee (a total of \$885). Please charge any additional fees or credit any overpayments to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,



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I hereby certify this correspondence is being submitted to Commissioner for Patents, Alexandria, VA 22313-1450 by facsimile transmission on November 23, 2004, fax number (703) 872 9306.



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